

typographical errors that may have occurred. It is noted that throughout the Specification where trademarks and trade names have been used, they have been capitalized.

CLAIM REJECTION 35 U.S.C. §112

5 Turning now to Paragraphs 2 and 3, Claims 11 to 15 have been rejected under 35 U.S.C. §112. The Examiner states in Paragraph 3 that Claims 11 to 15 are rejected because the Specification does not reasonably provide enablement for second surface with a dark colored surface.

10 Claim 11 is the independent claim in this group and specifies that the substrate has first and second surfaces, one being light colored and the second surface being dark colored. Reference is made to the Specification, Page 4, Lines 5 through 8, where substrates 12 is described as being transparent or opaque. The Specification further suggests that the front surface may be flood coated with white or light reflecting screen printing or the like. It is submitted that the same technique, as well as others such as
15 other well known coating methods for applying inks or dyes, may be used to create a dark surface. Such techniques are well known to those in the printing arts. Further, films having various colored surfaces are readily available from fabricators.

20 The enablement requirement 35 U.S.C. §112 requires the written description teach those in the art how to make and use the invention as broadly as is claimed without undue experimentation. Since the patent suggests various coating techniques as a method of applying colorization to a surface, it would be within the skill of the art to flood coat a

surface of the film with a dark or light absorbing coating by screen printing. The only change necessary would be the color. Further, the specification suggests that the adhesive may be pigmented with a black or light absorbing pigment, similarly it would be within the skill of the art to directing apply a pigment to the surface so that the surface is dark colored, rather than utilizing a dark colored pigment.

Claim 14 includes the step of applying an adhesive to the second surface which is dark colored. Referring to Page 4, Lines 13 through 15, the Specification describes applying an adhesive layer such as an acrylic by rolling or spraying to a surface of a substrate. Thus, Claim 14, directed to an adhesive layer, is clearly within the contemplation of specification when contemplated by one skilled in the art. The Federal Circuit has stated "A patent need not teach and preferably omits what is well known in the art." 3 USPQ 2d @ 1743

CLAIM REJECTIONS

Turning now to the claim rejections, Claims 1 to 7 and 11 to 15 have been rejected as being unpatentable over Shields, U.S. Patent No. 5,773,110 in view of Andriash, U.S. Patent No. 5,679,435 and Mimura, et, al., U.S. Patent No. 5,002,825. Claims 1, 4 and 11 are the independent method claims presently under consideration.

The present application is a divisional of U.S. Patent Application SN 09/037,315, entitled "One-Way, See-Through Panel & Method of Making Same," now U.S. Patent No. 6,258,429.

A brief review of Applicant's invention is believed helpful in resolving prosecution issues. The Applicant's invention relates to a method of producing one-way vision or see-through panels of the type in which a graphic image is applied to a flexible substrate. The substrate is perforated and adhered to a transparent surface providing the one-way vision characteristics. Applicant's claims relate to the use of ink jet technology for creating a superior image on see-through vision panels. In order to obtain the necessary high quality image, the flexible film, such as a polyester film, is top-coated in order to encapsulate and absorb the ink and provide the degree of resolution necessary. Dyes and inks used in ink jet applications are hydrophilic and will laterally migrate when applied to the film. The Applicant suggest various substances which may be used to encapsulate the dyes and pigments and prevent bleeding. Synthetic films used in one-way panels, such as polyesters and vinyls which are not top-coated will not absorb certain types of ink, particularly dyes and pigmented inks. The top coating, as suggested by the Applicant, may be clays, resins, gels or latex combination coating. A significant advantage of the product produced by the method is that it can be pre-printed with an image by ink jet and provided to the user ready of application by simply removing the backing and adhering it to a window.

U.S. PATENT NO. 6,258,429

The Applicant's issued patent is directed to a one-way, see-through panel, whereas the present application is directed to a method of producing the panel which, essentially,

consists of providing an opaque substrate having opposite surfaces, applying a dark pigmented adhesive to the first surface of the substrate or alternately applying an adhesive to the second surface which is dark colored, top-coating a second surface with an ink jet encapsulating substance, perforating the top-coated substrate and release liner, applying
5 an imperforate barrier over the release liner and applying an image to the second surface by the use of an ink jet applicator. The imperforate barrier of Claims 1 and 4 is important because it provides protection during the application of the image against bleed through of inks to the opposite surface. If the barrier liner is not applied, there is a possibility of the applied ink jet images passing through the holes to the opposite side of the substrate. ✓

10 Shields is cited as teaching a method for producing a one-way, see-through panel which includes providing an opaque white colored substrate. The Shields '110 patent relates to a method of making a display in which a perforated panel is provided with layers of paint. The perforated panels are applied to the window with tape or similar adhesive. The outer surface is painted with an image. Once the painted layer has dried,
15 the panel is separated and masking tape or adhesive removed and the perforated panels are applied to the window and the holes allow the observer to see through the panel from one side to the other. Thus, Shields does not teach a method in which the image is applied by ink jet technology. Rather, Shields deals with a conventional method of applying images by painting (apparently hand-painting) or unspecified printing methods. ✓
20 Further, Shields discounts the importance of perforation, saying it is only necessary that the panel which is to be painted is perforated. Shields further suggests that the panel or

adhesive layer removable backing may or may not be perforated. Thus, Shields does not in any way suggest placing a barrier over the release liner which, as pointed out above, which is set forth in Applicant's Claims 1 and 4, to prevent bleeding.

Most important, as the Examiner recognizes, Shields does not teach applying an image by ink jet printing and, accordingly, does not suggest a top coating. Basically Shields appears to deal with the application of a perforated panel which is applied to a window and, in turn, hand-painted by a sign painter which would teach away from Applicant's invention which results in a preprinted panel which is printed with a high quality graphic image which can then simply be directly applied to a surface by removing the backing and applying the adhesive surface to the surface of the transparent window.

Andriash is cited as a method for producing a see-through panel, including applying an image to a substrate by printing or painting where the printing includes ink jet printing. Andriash deals with retro-reflective vision panels which includes an opaque sheet material coated with retro-reflective light reflecting particles. An image is formed over the top of the retro-reflective particles using colored light printable translucent inks or films to form an image. The Applicant is well aware of retro-reflective films, particularly perforated retro-reflective films. The Applicant is the inventor named in U.S. Patent No. 5,925,437, which deals with retro-reflective films of this type.

Retro-reflective sheet materials of the type utilized in the Andriash patent are specialized materials containing glass beads or other retro-reflective particles printed to form an image with light permeable translucent inks to allow reflected light to pass

through the inks. The printing may be with electrostatic transfer method such as silk screening, ink jet printing or other convention methods of image development. Thus, Andriash deals with a very specific type of retro-reflective sheet material containing glass beads and the like and using special inks, namely light permeable translucent inks. There is no discussion of top-coating or any treatment necessary for the surface to receive the image. The Patentee does suggest that a clear laminent with UV inhibitors may be necessary to seal the structure and permit it to be cleaned.

Since the Examiner acknowledges Shields teaches painting or printing, as discussed above, and Andriash deals with a very specialized retro-reflective substrate, it is submitted that the combination of Shields and Andriash is not proper as there is no objective teaching that would lead one of ordinary skill to combine the relevant teaching of the references. Further, the modification of Shields by Andriash would not result in the Applicant's invention but rather would basically result in Shields modified to incorporate retro-reflective surfaces.

Mimura, et al., recognizes that a problem exists when applying printing, such as offset or ink jet printing, to a porous film. Mimura, et al., suggest that if the porous layer has a specific peak pore diameter, a specific undulation index, better drying speed then clearness of the printing will result. The acquired surface is prepared by mixing water disbursable polymer and a specific colloidal silica and specific ratios and applying the mixture on the base film. Thus, the Mimura patent does not in any way suggest an ink jet

encapsulating under an ink jet printer image, but rather deals with the control and porosity of the surface layer.

The combination of Shields, Andriash and Mimura, et al., is inappropriate as each deals with a different problem and hence there is no motivation or suggestion to combine perforated painted signage, retro-reflective panels and surface film porosity teachings.

CLAIM 2

Regarding Claim 2, this claim is urged allowable for the reasons set forth above. No claim, per se, is made to the use of films other than in connection with the method of Claim 1.

CLAIM 3

Regarding Claim 3 in which specific top coatings are set forth, Mimura, et al., discuss preparing the surface layer to control the porosity and does not relate to perforated films.

CLAIM 4

Claim 4 is urged allowable for the reasons set forth above. Further, there is no suggestion in any of the reference patents to specifically apply ink jet technology to perforated films and, further, to utilize a removable imperforate barrier to a surface at the time an image is applied to prevent bleeding.

CLAIMS 5 TO 7

Claims 5 to 7 are urged allowable for the reasons set forth above. Further, as pointed out, there is no suggestion in any of the references cited to use specific inks set forth in Claim 5. However the use of a specialized ink jet applicator which is a piezo ink jet applicator or a thermal applicator.

CLAIMS 11 TO 15

With regard to Claim 11, reference is made to the discussion with respect to Shields above. Basically, it is again emphasized that Shields suggests that the panel 80 on which the image to be painted or printed is opaque, it may be backed with a dark color adhesive. Contrary to this, Applicant's Claim 11 specifies a substrate having a first surface which is light colored and a second surface which is dark colored. Further, Shields, as acknowledged by the Applicant, does not teach use of ink jet technology, but rather suggests that the panel can be painted or printed. Andriash deals with a very specialized material, retro-reflective films, and the utilization of specialized inks and dyes and does not in any way deal with the problem of treating a surface to receive ink jet image application.

Mimura, et al., while dealing with the problem of making a porous film suitable for printing, does not in any way deal with see-through signage technology and, further, suggests a very specific treatment to control porosity in order for inks to properly adhere.

In the rejection, the Examiner has relied on a combination of references to conclude that the claimed subject matter as a whole would have been obvious to a person

of ordinary skill in the art to which the subject matter pertains at the time the invention was made. Such as combination is proper only if there is some objective teaching of the prior art or incentive which would lead one of ordinary skill to combine the relevant teachings of the references. The references are from diverse areas which, as pointed out
5 above, are not properly combinable to sustain an obviousness rejection.

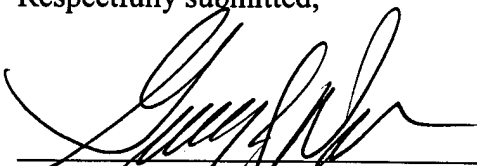
The Applicant's invention as a whole relates to a method and process of producing an image on a specialized substrate namely perforated film. With the Applicant's invention a number benefits flow, including a graphic image of high quality that properly adheres to the substrate and can be used for signage even in adverse conditions. The
10 resulting image can be pre-produced and supplied to the user to be simply applied by removing the backing to expose an adhesive and placing the image on the window.

In view of the foregoing, it is believed that the claims as they presently stand in the application are distinguishable and patentable over the prior art.

A petition and requisite extension fee accompanies this Response. A favorable
15 action is respectfully solicited.

Dated: MAY 7, 2003

Respectfully submitted,



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